

REMARKS

I. Introduction

Claims 1 and 3-25 are pending in the present application after the addition of claims 24-25 and cancellation of claim 2. Claims 3, 5, 7, 9, 10, 13-15, 17 and 19-23 are withdrawn from further consideration by the Examiner. Although Applicant notes the withdrawal of claims 3, 5, 7, 9, 10, 13-15, 17 and 19-23 from further consideration, Applicant has amended claims 3, 5, 9, 10, 13, 14, 15, 17, 19-21 and 23 in order to clarify the claims (e.g., incorporate the formal changes suggested by the Examiner in connection with the claims under consideration).

Claims 1, 2, 4, 6, 8, 11, 12, 16 and 18 under consideration have been rejected. In response to the Examiner's rejection, Applicant has canceled claim 2, and amended claims 1, 4, 6, 8, 11, 12, 16 and 18.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

II. Claim Objections

Claims 4 and 8 have been objected to because of some informalities. In response, Applicant has amended claims 4 and 8 in accordance with the Examiner's suggestion.

III. Rejection of Claim 16 under 35 U.S.C. § 112, First Paragraph

Claim 16 has been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In this regard, the Examiner states that "claim 16 recites limitation 'a control part' which corresponds to control part 106 in Figure 10," but "there is no support for the limitation 'a transmittance control device,' which is recited in claim 16." In response, "a transmittance control device" limitation has been deleted.

IV. Rejection of Claims 1, 2 and 8 under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2 and 8 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In response to the rejection, claim 1 has been amended to recite “a focal length” in line 7, and claim 8 has been amended to recite “the plural optical systems.” Claim 2 has been canceled. Applicant submits that these amendments obviate the indefiniteness rejection.

V. Rejection of Claims 1, 2, 4, 6, 8, 11 and 12 under 35 U.S.C. § 102(b)

Claims 1, 2, 4, 6, 8, 11 and 12 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,801,958 (“Stoneham”).¹ Claim 2 has been canceled. Applicant respectfully submits that Stoneham fails to anticipate pending claims 1, 4, 6, 8, 11 and 12, for the reasons explained below.

To anticipate a claim under 35 U.S.C. §102(b), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Furthermore, in order to rely on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). “Inherency, however, may not be established by probabilities or possibilities,” i.e., “mere possibility that a certain thing may result from a give set of circumstance is not sufficient.” In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

¹ Although the Examiner states that the rejection is made under 102(e), Applicant believes the Examiner intended to cite 102(b) as the basis for the rejection.

Amended claim 1 recites, in relevant parts, “an imaging element, plural optical systems having different focal lengths, a variable-transmittance element, and a **reflective optical element consisting essentially of a reflective surface that is fixedly positioned,** and wherein a focal length of the imaging apparatus in its entirety is changed by controlling transmittance of the variable-transmittance element.” As indicated on page 2, lines 18-21 of the present specification, an object of the present invention is to provide an imaging apparatus that achieves a variable focal length without a mechanically movable part. Therefore, the reflective element included in the imaging apparatus of the present invention does not have a mechanically movable part, and **consists essentially of a fixedly positioned reflective surface**. In contrast to the claimed feature, Stoneham discloses (as described in column 2, lines 59-65 and shown in FIGs. 2 and 3) that the reflective optical element is mechanically moved for switching between the paths of rays of the plural optical systems (long-focus lens 1', short-focus lens 3').

For at least the foregoing reasons, amended claim 1 and its dependent claims 4, 6, 8, 11 and 12 are not anticipated by Stoneham.

VI. Rejection of Claim 18 under 35 U.S.C. § 103(a)

Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,801,958 ("Stoneham") in view of U.S. Patent No. 5,471,339 ("Ise"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent the Examiner may be relying

on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 18 depends on claim 1. As discussed above, Stoneham clearly fails to anticipate parent claim 1. In addition, Ise fails to remedy the deficiencies of Stoneham as applied against claim 1. Accordingly, the combination of Stoneham and Ise fails to render obvious claim 1 or its dependent claim 18.

VII. New Claims

Since claims 24 and 25 depend from claim 1 (which has been shown to be in allowable condition), claims 24 and 25 are allowable by virtue of their dependence on allowable claim 1.

VIII. Conclusion

In view of the foregoing, it is submitted that all of the presently pending claims under consideration are in allowable condition. It is therefore respectfully requested that the present application issue as early as possible.

Respectfully submitted,

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